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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,152	10/16/2003	Brian R. Harris JR.	702.125	8217

37902 7590 10/17/2006

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EXAMINER

HOUSTON, ELIZABETH

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,152

Applicant(s)

HARRIS ET AL.

Examiner

Elizabeth Houston

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/16/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Invention I, apparatus (claims 1-11), in the reply filed on 08/18/06 is acknowledged. The traversal is on the ground(s) that the method and apparatus are both drawn to a grasping instrument and that they have not acquired a separate classification in the art. This is not found persuasive because the inventions are distinct since the apparatus can be used in a materially different method. In addition to the apparatus being used in a method such as removing tissue for a biopsy, the apparatus can be additionally used in methods such as occluding or clamping vessels, extracting stones from the kidney or acting as a retractor. More simply, the apparatus can be used in method that does not require a suture or a U-shaped opening. Additionally the two inventions have acquired a separate classification and would put a serious burden on the examiner. Invention I, apparatus, as stated would be classified in 606/205 since what is claimed is merely forceps and does not require needle for puncturing or use of a suture. However Invention II, requires the use of suture and needle, thus requiring the function of puncturing and piercing (606/167) as well as suturing (606/148).

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 12-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or

linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 08/18/06.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8, 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Thal (US 2002/0103493).
4. Thal discloses a surgical instrument comprising a handle (32, 42), a body portion (22), and a jaw portion (14, 18) comprising first and second jaws for gripping tissue. The second, lower jaw has a closed perimeter hole extending through (Fig. 6). The first jaw has a slit (narrow channel seen in Fig. 7) that is opposite the body portion. The first jaw has a center hole (142) that is in communication with the slit. The slit is narrower than the center hole. The teeth of the jaws are out of phase with each other and spaced apart from each other (Fig. 11). The first and second jaws are parallel.
5. Claims 1-8, 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Nolan et al. (USPN 5,776,150).
6. Nolan discloses a surgical instrument comprising a handle (14, 12), a body portion (20), and a jaw portion (30) comprising first and second jaws for gripping tissue. The second, lower jaw has a closed perimeter hole extending through (as seen at pin 46, Fig. 3). The first jaw has a slit (27) that is opposite the body portion. The first jaw has a center hole (40) that is in communication with the slit. The slit is narrower than the

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center hole. The teeth of the jaws are out of phase with each other (Fig. 4) and spaced apart from each other (when the jaws are opened). The first and second jaws are parallel.

7. Claims 1-8, 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Fogarty et al. (USPN 6,228,104).

8. Nolan discloses a surgical instrument comprising a handle (52, 54), a body portion (60,62), and a jaw portion (66,68) comprising first and second jaws for gripping tissue. The second, lower jaw has a closed perimeter hole extending through (Fig. 2, 84)). The first jaw has a slit (82) that is opposite the body portion. The first jaw has a center hole (84) that is in communication with the slit. The slit is narrower than the center hole. The teeth of the jaws are spaced apart from each other (when the jaws are opened). The first and second jaws are parallel.

9. Claims 1, 2, 7, 8, 9, 11 rejected under 35 U.S.C. 102(b) as being anticipated by Yamauchi et al. (USPN 6,273,887).

10. Yamauchi discloses a surgical instrument comprising a handle (17,6), a body portion (2) and a jaw portion (3). The second jaw that is the lower jaw (8b) has a closed perimeter hole (25, Fig. 2). The jaws are parallel and the teeth are out of phase and spaced apart (Fig. 2). The teeth are coated with a tissue protecting material (Col 8, line 59-65).

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Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thal in view of Heimberger et al. (USPN 5,562,699).

13. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nolan in view of Heimberger et al. (USPN 5,562,699).

14. Thal and Nolan both disclose the invention substantially as claimed as stated above. Thal and Nolan do not disclose a handle having an overpressure linkage.

15. Heimberger discloses a surgical apparatus comprising a handle portion, a body portion and a jaw portion for gripping tissue. Heimberger further discloses a force transfer and limiting member operatively connecting the handle to the jaws for transmitting and limiting user-applied force to prevent damage to the tissue being treated (Col 1, lines 45-Col 2, line 5).

16. It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate a limiting element into the handle of the surgical jaws in order to prevent damage to the patient's tissue. Heimberger offers the motivation. The inventions are analogous with each other and the instant invention and therefore the combination is proper.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Houston whose telephone number is 571-272-7134. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

eh 


ANH TUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER
02/14/06